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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,512	01/25/2001	Hiroshi Kodama	Q62804	5316

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EXAMINER	
TRAN, HIEN THI	
ART UNIT	**PAPER NUMBER**
1764	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/768,512	KODAMA ET AL.	
	Examiner	Art Unit	
	Hien Tran	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2004 and 22 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 6-14* is/are pending in the application.

4a) Of the above claim(s) *11-14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 6-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1,2 and 6-14* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 11-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, 6-10, drawn to a metallic carrier for a catalytic converter, classified in class 422, subclass 180.

II. Claims 11-14, drawn to a method for manufacturing a metallic carrier, classified in class 29, subclass 890.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process, such as the one not restricting the joining area.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 11-14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, in claim 9, the newly added claim is nowhere disclosed in the specification. See claim 10 likewise.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9, 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, it is unclear as to where it is disclosed in the specification as on pages 4-5 and throughout the specification, applicants disclose that the brazing material holds in the grooves.

In claim 10, it is unclear as to where it is disclosed in the specification that the groove is provided on "only" one end of the cylinder.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 1-2, 6-10 are rejected under 35 U.S.C. 103(a) as obvious over Usui et al (4,948,774 or 5,026,611) alone or in view of JP 08-141413 and Nonnenmann et al (4,248,186).

Usui et al discloses a metallic carrier for a catalytic converter comprising:

a corrugated sheet 4 made of metal;

a flat sheet 3 made of metal;

a core 1 formed by superposing the corrugated sheet and the flat sheet one on another and by rolling the corrugated sheet and the flat sheet in multiple times;

a brazing material surrounding an outer periphery of an exhaust gas outlet side and an exhaust gas inlet side of the core; and

a metallic outer cylinder 6;

wherein an assembly including the core and the brazing material is forcedly enclosed in said metallic outer cylinder 6 (col. 7, lines 25-30 in Usui '774 and col. 6, lines 25-32 in Usui '661);

wherein the metallic outer cylinder 6 is subjected to heat treatment to join the corrugated and flat sheets, and to join an inner periphery of the metallic outer cylinder and an outer periphery of the core by the brazing material; and

wherein at least one solder-rising preventing groove 7 is defined over an entire circumference of the inner periphery of the outer cylinder 6 at a position located on an exhaust gas inlet side of an area for joining the core.

Although Usui et al is silent as to whether the corrugated sheet and the flat sheet may be diffusionally joined, such diffusion joining is directed to method limitation which is of no patentable moment in apparatus claims.

It appears that the claim is a product-by-process claim and when the patentability of a product-by-process claim is determined, the relevant inquiry is whether the product itself is patentable. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). If a product is the same as or would have been obvious to one having ordinary skill in the art from a product of the prior art, the product is unpatentable even though the prior art product was made by different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

Since the product of the instant claim is substantial the same as that of Usui et al, it is unpatentable even though the product of Usui et al may be made by different process. Similar, the features of "brazing foil material wound around" and "press-fitted" are directed to a method of manufacturing the metallic carrier which are of no patentable moment in apparatus claims for the same reasons set forth above. It should be noted that the method of forming the device is not germane to the issue of patentability of the device itself.

Note that since the core and the brazing material in Usui et al is forcedly enclosed in said metallic outer cylinder 6 (col. 7, lines 25-30 in Usui '774 and col. 6, lines 25-32 in Usui '661) which is considered as "press-fitted".

In any event, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an appropriate method for connecting the sheets and using the brazing foil for joining the core to the outer cylinder as taught by JP 08-141413 and press-fitting the core and brazing material into the outer cylinder as taught by Nonnenmann et al in the apparatus of Usui et al, as an alternative method of manufacturing the metallic carrier, as such is conventional in the art and no cause for patentability here.

With respect to claim 8, Usui et al '774 discloses that the grooves may be formed in a variety of fashions and not limited to the illustrated embodiments (col. 4, lines 26-37).

Furthermore the shape of the grooves is not considered to confer patentability to the claim. It would have been an obvious matter of design choice to select an appropriate shape for the grooves, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill

in the art, absence showing any unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to claims 9-10, as discussed in the 112 rejection above, the newly added claims introduce new matter. Therefore, the difference between applicants' claim carrier and that of the prior art cannot be identified by the specification of the instant application.

Response to Arguments

14. Applicant's arguments filed 6/24/04 and 07/22/04 have been fully considered but they are not persuasive.

Applicants argue that in the instant invention, the brazing foil material is not provided in the solder-rising preventing groove, while in Usui '744 the grooves 7 serve to retain the brazing material 8 and therefore Usui '774 fails to teach the features recited in claim 1. Such contention is not persuasive as apparently the solder-rising preventing grooves in the instant claim and in Usui '774 are serving the same purpose, to hold the brazing material so as the melted brazing material would not rise across the grooves thereof. Furthermore, in Usui '774, one of the brazing materials 8 locates at the exhaust outlet side and one of the grooves 7 locates at the exhaust inlet side and therefore the carrier of Usui '774 meets the instant claim.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hien Tran

Hien Tran
Primary Examiner
Art Unit 1764

HT
October 13, 2004